

REMARKS

The Examiner's communication dated December 6, 2004 has been received and carefully considered. In conformance with the applicable statutory requirements, this paper constitutes a complete reply and/or a bona fide attempt to advance the application to allowance. Specifically, claim 4 has been amended, claims 12-27 have been cancelled and new claims 28-43 have been added. Reexamination and/or reconsideration of the application as amended are respectfully requested.

Summary of the Office Action

Claim 4 was objected to for a minor informality.

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bourne (U.S. Patent No. 4,365,831) in view of Dean (U.S. Patent No. 6,095,574).

Claim Objection(s)

Claim 4 has been carefully amended to resolve the claim objection(s) noted by the Examiner.

The Claims Distinguish Patentability Over the Reference(s) of Record

Claim 1 calls for a door and latch assembly for use on an electric arc engine welder to include a door mounted on an associated arc engine welder housing, a latch pivotally mounted on the door and a locking device on the door. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify "the channel latch for a door and latch assembly, as disclosed by Bourne, by adding the enclosure locking device taught by Dean, in order to prevent unauthorized access to internal components of the enclosure" (Office Action at page 4). Applicant respectfully disagrees.

Applicant respectfully asserts that Bourne and Dean are directed toward nonanalogous art. While Bourne relates to a latch assembly for use in applications wherein the latched surface is subjected to pressure and acceleration loading (Col. 1, lines 6-8), Dean relates to methods and apparatus for locking computer enclosures in order to prevent access to internal components of the computer enclosure (Col. 1, lines 5-7). Applicant asserts that the fields of endeavor of the two applied references are entirely distinct and not likely to be cross-referenced by applicants or those skilled in the art practicing in one or the other of the two fields of endeavor.

Moreover, Applicant asserts that one skilled in the art would not look toward computer enclosure locking structures to improve a door and latch assembly of an electric arc engine welder. In other words, one skilled in the art would not be motivated to combine Bourne with Dean and apply the combined references to an electric arc engine welder. The Examiner has provided no reference, or other evidence, to support his conclusion that it would be obvious to one skilled in the art to modify Bourne with the teachings of Dean. Applicant asserts that the Examiner has impermissibly concluded that claim 1 is obvious in view of a combination of Bourne and Dean without any legitimate support on the record and respectfully requests that, in accordance with the obligations imposed under MPEP § 2144.03, the Examiner provide a reference or other suitable evidence showing that one skilled in the art would be motivated to modify the teachings of Bourne with the teachings of Dean and apply both to an electric arc engine welder.

As the Examiner is aware, a *prima facie* case of obviousness is not established absent proper motivation. Simply because the channel latch of Bourne could be modified to include the computer enclosure locking structure of Dean, and that this combination could be applied to an electric arc engine welder housing, this is not motivation to modify, combine and apply these teachings to meet the limitations of claim 1. Moreover, according to MPEP § 2144.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." Merely because the claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. *See MPEP § 2141.01 citing Ex parte Levensgood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Consequently, absent a motivation to combine and modify the references, it is irrelevant that the elements and/or limitations may be individually or separately known in the prior art. Clearly, the Examiner is motivated to combine Bourne and Dean, and apply these references to an electric arc engine welder housing, for no other reason than to arrive at the claimed invention of claim 1. This is a classic example of impermissible hindsight.

Assuming *arguendo* that the combination of Bourne and Dean is obvious, and that it would be further obvious to apply the combination to an electric arc engine welder, Applicant asserts that the limitations of claim 1 are still not met. More specifically, claim 1 calls for a latch to be rotatably mounted on a door. According to the Examiner's interpretation of Dean, the latch pin 70 is said to be the latch of claim 1.

However, with reference to FIGURE 9, the latch pin 70 is not mounted to a door, but is rather mounted to a computer enclosure 14 and is used to hold door 16 in a closed position. The Examiner appears to assert that the end panel 14 of the computer enclosure is a door (Office Action at page 3, line 14). Applicant challenges this assertion that a stationary or fixed end panel 14 can serve as a door as called for in claim 1. Further, the latch called for in claim 1 is required to be pivotally mounted on the door. It is unclear whether the Examiner is asserting that the latch pin 70 is pivotally mounted to a door.

Accordingly, for at least these reasons, Applicant asserts that claim 1 and claims 2-3 dependent therefrom are in condition for allowance.

Claim 4 calls for a door and latch assembly for use on an electric arc engine welder to include (i) a door, (ii) a latch rotatably mounted on the door and including a latch biasing member and a housing engagement portion, (iii) a latch trigger rotatably mounted on the door and including a latch trigger biasing member and a door engaging portion, and (iv) a locking device fixedly connected to the door. As already discussed, Applicant challenges the Examiner's combination of Bourne and Dean. Specifically, Applicant asserts that these references are directed toward nonanalogous art and that one skilled in the art would not be motivated to combine the teachings of Bourne with the teachings of Dean.

Moreover, Applicant asserts that Dean does not teach or fairly suggest a latch rotatably mounted on a door. As already discussed, Dean discloses a latch pin 70 mounted to a fixed end wall 14. Thus, the combination of Dean and Bourne fails to disclose or fairly suggest a latch rotatably mounted on a door.

Further, claim 4 calls for a housing engaging portion of the latch, which is mounted on the door, to limit movement of the door from its closed position to its open position. Dean fails to disclose or fairly suggest a housing engaging portion of a latch. Still further, claim 4 calls for the locking device to be fixedly, i.e., permanently, connected to the door. At best, Dean can be said to disclose a locking device connected to end panel 14. Thus, Dean does not disclose a locking device fixedly connected to a door. Accordingly, for at least these reasons, Applicant respectfully asserts that claim 4 is in condition for allowance.

Claim 5 call for an electric arc engine welder to include a housing, a door mounted to the housing, a latch pivotally mounted on the door, and a locking device adjacent the latch. As discussed above, Applicant respectfully asserts that the applied

combination of Bourne and Dean is impermissible, as these references are directed toward nonanalogous art and one skilled in the art would not be motivated to combine Dean with Bourne and apply the combination to an electric arc engine welder. Moreover, claim 5 calls for a latch to be pivotally mounted on the door. As discussed above, Dean fails to disclose or fairly suggest a latch pivotally mounted on a door. Accordingly, for at least reasons, Applicant submits that claim 5 and claims 6-11 dependent therefrom are in condition for allowance.

Applicant would like to highlight the limitations of dependent **claim 6** calling for a locking device to include a tab and a lock inserted through the tab. Independent claim 5 calls for a latch. As already discussed, the Examiner asserts that Dean teaches a latch and identifies latch pin 70. With respect to dependent claim 6, the Examiner appears to be asserting that latch pin 70 is also (in addition to being a latch) a lock inserted through a tab. Applicant asserts that two separate elements are called for by dependent claim 6. Specifically, claim 6 calls for the latch of claim 5 and, as a distinct element, a lock inserted through a tab which, when enabled, obstructs movement of the latch. The Examiner appears to use the latch pin 70 as both the latch of claim 5 and the lock of claim 6. Applicant respectfully asserts that these elements are separate and distinct and the Examiner cannot use latch pin 70 as both the latch of claim 5 and a lock, particularly when the lock obstructs movement of the latch.

New claims 28-43 have been added. Many of the limitations of these claims parallel those of original claims 12-27 which were restricted out for failing to be directed toward an electric arc engine welder having a welder housing including a door. New claims 28-43 have been appropriately crafted to be directed toward an electric arc engine welder and to include and/or relate the claimed elements to a welder housing and a door or a welder housing.

CONCLUSION

All formal and informal matters having been addressed, it is respectfully submitted that this application is in condition for allowance. It is believed that the claim changes clearly place the application in condition for allowance, defining over any fair teaching attributable to the references of record. Alternatively, if the Examiner is of the view that the application is not in clear condition for allowance, it is requested that the Examiner telephone the undersigned for purposes of conducting a telephone interview

to resolve any outstanding differences. Accordingly, an early notice of allowance is earnestly solicited.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

January 20, 2005
Date



Robert V. Vickers, Reg. No. 19,504
Erik J. Overberger, Reg. No. 48,556
1100 Superior Avenue
7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582

Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

- ☒ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
- ☐ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AMENDMENT, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:
Date
January 20, 2005

Signature

Printed Name
Audrey M. Dragony